

REMARKS

Claims 1, 3, 5, 6 and 27-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Magee et al. (U.S. Patent Application Publication Number 2004/0198379, hereinafter "Magee") and claims 2, 4, 7-26 and 29-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Magee in view of Chen et al. (U.S. Patent Application Publication Number 2003/0157945, hereinafter "Chen"). The Examiner's thoughtful reply in the *Response to Arguments* section of the present office action is appreciated; however, respectfully disagreeing, reconsideration is requested by the applicants.

Independent claim 1 as amended recites "monitoring, by a wireless communications network, messaging and messaging responses of a mobile station (MS), wherein the messaging and the messaging responses do not specify a presence state of the MS or a presence state change by the MS; inferring, by the wireless communications network, a change in the presence state of the MS based upon the monitoring." Independent claim 28 as amended recites "a wireless presence proxy... adapted to monitor the messaging and the messaging responses of the MS, wherein the messaging and the messaging responses do not specify a presence state of the MS or a presence state change by the MS, adapted to infer a change in the presence state of the MS based upon the monitoring." The Examiner cites FIG. 2 boxes 110 and 112 and Magee [0014] as teaching this claim language. Magee [0014-0017] (the text describing FIG. 2 boxes 110 and 112 is included in Magee [0016-0017]) reads (emphasis added):

[0014] Instant messaging and presence server (IMPS) 70 is coupled to location server 60 and to presence proxy 50. Presence proxy 50, location server 60 and presence server 70 comprise the packet switched portion of the home network 100. When location server 60 detects the mobile station 10 within a particular geographic area for which presence services are available, location server 60 sends a signal which triggers presence server 70. Presence server 70 evaluates the particular subscriber 10 against the stored contact list. If the contact list and its associated database indicate notification of presence services are permissible, presence server 70 sends the information via presence proxy 50 to mobile station 10 via base station 20. Location server 60 detects particular conditions for

transmitting the triggering signal to presence server 70. For example, if mobile station 10 has entered a shopping mall, school or sports stadium, for example.

[0015] Typically, the mobile station 10 determines its geographic location and updates location server 60 with its location.

[0016] Referring to FIG. 2, a flow chart of the operation of the mobile station or device 10 is shown. The process is started and block 110 is entered. The user or subscriber powers on the mobile station, block 110. Next, block 112 is entered which the mobile station determines whether it is provisioned for the presence feature. If the mobile station 10 is not equipped or provisioned with the presence feature, block 112 transfers control to block 114 which ends the process.

[0017] If the mobile device is equipped with the presence feature, block 112 transfers control to block 116 via the yes path. In block 116 the subscriber requests location notification lists from the presence server 70. Next, in block 118 the presence server 70 downloads or transmits the notification list associated with that geographic location to the mobile station 10.

The amended claims recite that the messaging and the messaging responses monitored do not specify a presence state of the MS or a presence state change by the MS. Assuming one equates "location" with "presence state," as it appears the Examiner is doing, Magee [0015] appears to teach away from this portion of the claim language with the MS determining its geographic location and then updating the location server 60 with its location.

In the *Response to Arguments* section of the present office action, the Examiner asserted that the claim language, in particular the phrase "do not explicitly specify," was vague. From the Examiner's comments, the applicants believe that the word "explicitly" added to the Examiner's uncertainty as to the meaning of the claim. The applicants can understand this point of view and submit that the word "explicitly" adds very little to what the other claim language already says. Thus, the applicants have deleted it from the claims in order to make the claims more clear.

Regarding claims 2, 4, 7-26 and 29-33, which stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Magee in view of Chen, the applicants submit that the Examiner has not provided an adequate motivation for combining Magee and Chen. For example, regarding claim 2, the Examiner states that it would have been obvious to one of ordinary skill in the art "to include the messaging responses in order to

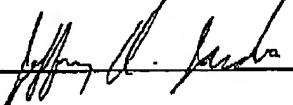
acknowledge whether or not the device is still in communication." However, the applicants submit that Magee does not suggest that other messages such as a page response, a short data burst (SDB) acknowledgment, a status response message, a short message service (SMS) acknowledgment, or a layer 2 acknowledgment could also be monitored to infer a change in a presence state. In addition, Chen does not appear to be concerned about the presence state of mobiles nor does Chen appear to suggest that any of the messages Chen describes might be monitored to infer a change in a mobile's presence state.

Again, regarding claim 2 for example, the Examiner states that it would have been obvious to one of ordinary skill in the art "to include the messaging responses in order to acknowledge whether or not the device is still in communication." However, the Examiner has failed to provide support in the prior art for this statement. For the Examiner to establish a *prima facia* case of obviousness, the Examiner must provide a teaching or suggestion from the prior art to combine the references. The applicants respectfully request the Examiner either to provide a teaching or suggestion from the prior art to combine the cited references in the rejection of claims 2, 4, 7-26 and 29-33 or to withdraw the rejection. The Examiner may not use a hindsight analysis of the applicants' application to support a *prima facia* case of obviousness.

Since none of the references cited, either independently or in combination, teach all of the limitations of independent claims 1 or 28, or therefore, all the limitations of their respective dependent claims, it is asserted that neither anticipation nor a *prima facie* case for obviousness has been shown. No remaining grounds for rejection or objection being given, the claims in their present form are asserted to be patentable over the prior art of record and in condition for allowance. Therefore, allowance and issuance of this case is earnestly solicited.

The Examiner is invited to contact the undersigned, if such communication would advance the prosecution of the present application. Lastly, please charge any additional fees (including extension of time fees) or credit overpayment to Deposit Account No. 502117 ~ Motorola, Inc.

Respectfully submitted,
V. Oprescu-Surcobe et al.

By: 

Jeffrey K. Jacobs
Attorney for Applicant(s)
Registration No. 44,798
Phone No.: 847/576-5562
Fax No.: 847/576-3750